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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,767	02/25/2004	Daniel P. Hurt	2004-2148.ORI	2853

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EXAMINER

NOVOSAD, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding..

Office Action Summary	Application No.	Applicant(s)	
	10/786,767	HURT, DANIEL P.	
	Examiner	Art Unit	
	Christopher J. Novosad	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 6,7 and 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-5 and 8 in the reply filed on December 19, 2005 is acknowledged. The traversal is on the ground(s) that "the examiner will necessarily search for and evaluate the subject matter of Claims 6, 7 and 9-13 in conducting the examination of claims 1-5 and 8." This is not found persuasive because, as explained in the Requirement for Restriction dated November 10, 2005, the inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require receptacles. The subcombination has separate utility such as in situations not requiring two spaced apart and substantially parallelly disposed proximal members.

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as in situations requiring a pivot means. See MPEP § 806.05(d).

Art Unit: 3641

Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require receptacles. The subcombination has separate utility such as in situations not requiring the proximal frame members to be spaced apart and substantially parallelly disposed with respect to one another.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

In view of the differences noted above, the subject matter of the different inventions is different.

Accordingly, Claims 6, 7 and 9-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Calef.

Art Unit: 3641

With respect to parent claim 1, Calef shows (Figs. 1-5) a hand tool comprising:

A frame (shank B) having a distal portion (unnumbered, at the lower end of Figs. 1-4) and a proximal portion (unnumbered, at the upper end of Figs. 1-4) generally defining a first axis (unnumbered) therebetween, the proximal portion having at least one proximal end (unnumbered, upper end of shank B);

(a) a working element (A) operably coupled (by rivets, unnumbered) to a distal end of the distal portion, the working element (A) having a working portion (bowl of the spoon) that is oriented along a first direction (unnumbered) with respect to the frame (B);

(b) a handle means (I) pivotally coupled to the frame (B) at a portion (unnumbered) thereof intermediate the proximal end (lower end of shank B) and the distal end (upper end of shank B); the handle means (I) having a pivot axis (about line x-x in Fig. 4) substantially perpendicular to the first axis (unnumbered); and

(c) a brace means (D, E) operably coupled to the proximal end (upper end of shank B) of the frame (B), the brace means (D, E) being configured to operably brace against an upper side of a user's forearm while the user operably grasps the handle means (I).

With regard to claim 8, the handle of Calef (I, in Figs. 3 and 4) is "removably securable to the frame" (B) as required in the claim. For example, it is capable of being placed on and removed from the shank (B) prior to securing the detachable arm-piece (D, E) on the shank (B), as shown in the embodiment of Figs. 3 and 4.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKittrick '627 in view of Calef.

With respect to claim 1, McKittrick '627 discloses a hand tool (10) comprising:

- (a) a frame 12 having a distal portion (20) and a proximal portion (40, 42) generally defining a first axis (unnumbered) extending therebetween, the proximal portion (40, 42) having at least one proximal end (40, 42);
- (b) a working element (14) operably coupled to a distal end (22) of the distal portion (20), the working element 14 having working portion (28, 30, 32) that is oriented along a first direction (unnumbered) with respect to the frame (12);
- (c) a handle means (50) coupled to the frame (12) at a portion (unnumbered) thereof intermediate the proximate end (40, 42) and the distal end (22), the handle means (50) having a pivot axis (unnumbered) substantially perpendicular to the first axis (unnumbered); and
- (d) a brace means (44) operably coupled to the proximal end (40, 42) of the frame 12, the brace means (44) being configured to operably brace against an upper side of a user's forearm while the user operably grasps the handle means (50).

As to claim 2, the proximal portion (40, 42) of the frame (12) diverges from the intermediate portion (unnumbered) into two spaced apart and substantially parallelly disposed proximal members (40, 42).

Art Unit: 3641

Regarding claim 3, the brace means (44) of McKittrick extends between the proximal members (40, 42).

With respect to claim 4, the brace means (44) of McKittrick is fabricated from a resilient material (note the disclosure of “flexibility” in col. 4, line 19 which would necessarily indicate that a resilient material is present).

As to claim 5, the working element (14) of McKittrick is removably secured via elements 20, 26, 22, 24 to the frame (12).

The claims distinguish over McKittrick ‘627 in requiring (1) the handle means to be pivotally coupled to the frame (*as required in claim 1*); and (2) the handle means to be removably securable to the frame (*as required in claim 8*).

Regarding the above-noted distinctions, Calef (Figs. 1-5), with respect to (1), above, shows a handle means (I) pivotally coupled via sleeve (G) to a frame (B) (*as required in claim 1*); and (2) the handle means (I) being removably securable to the frame (b) (*as required in claim 8*). In this respect the handle means (I) is capable of being placed on and removed from the shank (B) prior to securing the detachable arm-piece (D, E) on the shank (B), as shown in the embodiment of Figs. 3 and 4.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the hand tool of McKittrick ‘627 with the coupling structure (G, G’, H) of Calef to allow the handle means (50) of McKittrick to be pivotally coupled to the frame (12) of McKittrick for greater user versatility, efficiency, power and comfort especially in view of the clear teaching in Calef (col. 1, lines 50-52 and col. 2, lines 4-10) that the pivotally coupled

Art Unit: 3641

handle (I) “may be readily adjusted to fit conveniently into the hand” for operating the hand tool “with great power and efficiency.”

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J. Novosad whose telephone number is 571-272-6993. The examiner can normally be reached on Monday-Thursday 5:30am-4:00pm.

Art Unit: 3641

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Christopher J. Novosad
Primary Examiner
Art Unit 3641

August 21, 2006